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OFFICE OF PETITIONS

In re Patent No. 7,392,546	:	
Paul Patrick	:	LETTER REGARDING PATENT
Issue Date: June 24, 2008	:	TERM ADJUSTMENT AND
Application No. 09/878,536	:	NOTICE OF INTENT TO ISSUE
Filed: June 11, 2001	:	CERTIFICATE OF CORRECTION
Attorney Docket No. ORACL-01084US0	:	

This letter is in response to the "REQUEST FOR CERTIFICATE OF CORRECTION," filed April 17, 2009, which is properly being treated as a request that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy pursuant to patentee's duty of good faith and candor to the Office.

The request for review of the determination of patent term adjustment (PTA) is GRANTED to the extent indicated herein.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a patent term adjustment of **four hundred eighty-nine (489) days.**

Patentee is given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer**, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

On June 24, 2008, the above-identified application matured into U.S. Patent No. 7,392,546, with a revised patent term adjustment of 611 days. On April 17, 2009, patentee submitted the instant comment requesting correction of the patent by issuance of a certificate of correction showing a patent term adjustment of

550 days. Patentee does not state any basis for the request for review of the patent term adjustment.

The record reveals that patentee should have been assessed a delay under 37 CFR 1.704(b)¹ for filing a reply in the form of a Request for Continued Examination (RCE) on January 26, 2006, in excess of the three-month period from the August 26, 2005 mailing date of the final Office action. Thus, patentee failed to engage in reasonable efforts to conclude prosecution of this application. Accordingly, the period of adjustment should have been reduced under 37 CFR 1.704(b) by 61 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the final Office action, November 27, 2005, ending on the date the RCE was filed, January 26, 2006. A period of reduction of 61 days will be entered.

Additionally, patentee should have been assessed a delay under 37 CFR 1.704(b) for the filing of a reply in the form of a RCE on August 20, 2007, in excess of the three-month period from the April 18, 2007 mailing date of the final Office action. Accordingly, the period of adjustment should have been reduced under 37 CFR 1.704(b) by 33 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the final Office action, July 19,

¹ 37 CFR 1.704(b) states:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

2007, ending on the date the RCE was filed, August 20, 2007. A period of reduction of 33 days will be entered.

Further, a review of the application history confirms that the period of adjustment should have been reduced pursuant to 37 CFR 1.704(c)(8) for the filing of the Information Disclosure Statements on February 3, 2006 and October 18, 2007.

37 CFR 1.704(c)(8) provides:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

It is undisputed that patentee submitted Information Disclosure Statements on February 3, 2006 and October 18, 2007, after filing responses on January 26, 2006 and August 20, 2007, respectively. The record does not support a conclusion that the examiner expressly requested either the Information Disclosure Statement filed on February 3, 2006 or on October 18, 2007. Further, a review of the Information Disclosure Statements filed on February 3, 2006 and October 18, 2007, reveals that patentee did not include statements under 37 CFR 1.704(d).²

² Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Emphasis added.

The Office notes that patentee did not check the box next to the PTA Statement under 37 C.F.R. § 1.704(d) on the Information Disclosure

Thus, patentee failed to engage in reasonable efforts to conclude prosecution of the application.

Pursuant to 37 CFR 1.704(c)(8), the period of adjustment should have been reduced by eight (8) days, the number of days beginning on the day after the date the reply was filed, January 27, 2006, and ending on the date that the Information Disclosure Statement was filed, February 3, 2006.

Additionally, the period of adjustment should have been reduced by fifty-nine (59) days, the number of days beginning on the day after the date the reply was filed, August 20, 2007, and ending on the date that the Information Disclosure Statement was filed, October 18, 2007.

A period of reduction of 8 days will be entered for the submission of the Information Disclosure Statement on February 3, 2006. Additionally, a period of reduction of 59 days will be entered for the submission of the Information Disclosure Statement on October 18, 2007.

Lastly, a review of the record reveals that the period of delay of 38 days, pursuant to 37 CFR 1.704(c)(10), for the filing of the Replacement Sheet on May 8, 2008, after the mailing of the notice of allowance, was assessed in error.

37 CFR 1.704(c)(10) provides:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

Statements. However, even if patentee had checked the box, the Statement under 37 CFR 1.704(b) as it appears on the Information Disclosure Statements is not proper.

(ii) Four months;

It is noted that the Office incorrectly calculated the period of reduction under 37 CFR 1.704(c)(10) from the filing date of the Replacement Sheet, May 8, 2008, to the date the patent issued, June 24, 2008. However, the Office mailed a "Response to Rule 312 Communication" in response to the Replacement Sheet on May 16, 2008. As the Office responded to the Replacement Sheet on May 16, 2008, this date should have been used for the purpose of calculating the period of reduction under 37 CFR 1.704(c)(10). Accordingly, the period of adjustment of the term of the patent should have been reduced by 9 days, counting the number of days beginning on the date the Replacement Sheet was filed, May 8, 2008, and ending on the mailing date of the "Response to Rule 312 Communication", May 16, 2008.

As this period of reduction of 9 days for the filing of the Replacement Sheet totally overlaps³ with the 9-day reduction under 37 CFR 1.704(c)(10) for the filing of the Amendment under 1.312 and the IDS on May 8, 2008, no additional days of reduction will be entered for the filing of the Replacement Sheet. Accordingly, the period of reduction of 39 days will be removed.

In view thereof, the patent should have issued with a patent term adjustment of **489 days** (878 days of Office delay - 389 days (94 + 13 + 61 + 8 + 35 + 57 + 20 + 33 + 59 + 9) of applicant delay).

As this letter was submitted as an advisement to the Office of an error in patentee's favor, the Office will not assess the \$200.00 fee under 37 CFR 1.18(e). The Office thanks patentee for patentee's good faith and candor in bringing this to the attention of the Office.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of

³ 37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping."

correction indicating that the term of the above-identified patent is extended or adjusted by **489 days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,392,546 B2

DATED : Jun. 24, 2008

INVENTOR(S) : Patrick

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (611) days

Delete the phrase "by 611 days" and insert – by 489 days--